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cont
B4 cont
body and the propeller shaft and circumferentially between each adjacent pair of rubber spring elements, the stop elements including at least one of metal or rubber.

Please add new claims 19 and 20 as follows:

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D5
B5
--19. (New) A vibration damper for a tubular propeller shaft in the drive train of a motor vehicle, the vibration damper comprising:

a propeller shaft defining a radial and a circumferential direction;
a mass body arranged concentrically in the propeller shaft; and
a plurality of rubber spring elements for mounting the mass body to the propeller shaft;

wherein the mass body at least partially forms, in circumferentially opposite regions between the rubber spring elements, a plurality of stop elements for limiting a vibration travel of the mass body in at least the radial direction.

20. (New) A vibration damper for a tubular propeller shaft in the drive train of a motor vehicle, the vibration damper comprising:

a propeller shaft defining a radial and a circumferential direction;
a mass body arranged concentrically in the propeller shaft; and
a plurality of rubber spring elements for mounting the mass body to the propeller shaft;

wherein the propeller shaft at least partially forms, in circumferentially opposite regions between the rubber spring elements, a plurality of stop elements for limiting a vibration travel of the mass body in at least the radial direction.--.

REMARKS

I. Introduction

Claims 19 and 20 have been added herein. Therefore, claims 9 to 20 are pending in the present application. In view of the above amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all copies of the certified copies of the priority documents have been received from the International Bureau.

II. Objections to the Drawings

The Examiner objected to the drawings on the basis that "Figur" should be changed to --Figure--. The Examiner will note that enclosed herewith are proposed changes to the drawings as suggested. It is respectfully submitted that the corrected drawings obviate the objection, and withdrawal of this objection is respectfully requested.

III. Objections to the Specification

The Examiner objected to the Abstract on several grounds. In paragraph 3 of the Office Action, the Examiner appears to be referring to the Abstract of the published PCT application, publication number WO 99/06730. The present application includes the Abstract of record, which does not include the language objected to by the Examiner. In view of the foregoing, withdrawal of this objection is respectfully requested.

The Examiner objected to the Specification because of the use of the term "said" on page 7, line 24. In this regard, the Examiner will note that the Specification has been amended herein to change "Said" to --The--. No new matter has been added. It is respectfully submitted that the foregoing amendment obviates this objection, and withdrawal of this objection is respectfully requested.

IV. Rejection of Claim 14 Under 35 U.S.C. § 112

Claim 14 was rejected under 35 U.S.C. § 112, second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. While Applicants respectfully disagree, to facilitate matters, claim 14 has been amended herein to more clearly set forth "the second tube segment carrying the mass body on an outer contour." It is respectfully submitted that amended claim 14 fully complies with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 17 Under 35 U.S.C. § 112

Claim 17 was rejected under 35 U.S.C. § 112, first paragraph as not being supported by an enabling disclosure. The Examiner contends that the Specification does not support the limitation of metal stop elements. However, the Abstract states “Metal and/or flexible rubber stop elements that limit the vibration travel of the mass body at least in the radial direction are arranged between the mass body and the sleeve.” It is respectfully submitted that the foregoing provides an enabling disclosure of “the stop elements including at least one of metal or rubber” as recited in claim 17. Withdrawal of this rejection is therefore respectfully requested.

VI. Rejection of Claim 18 Under 35 U.S.C. § 102

Claim 18 was rejected under 35 U.S.C. § 102(b) as anticipated by FR 2 720 132 (“Michel”). Applicants respectfully submit that Michel does not anticipate claim 18 for the following reasons.

Claim 18 relates to a vibration damper for a tubular propeller shaft in the drive train of a motor vehicle. Claim 18 recites that the vibration damper includes a propeller shaft defining a radial and a circumferential direction, a mass body arranged concentrically in the propeller shaft and a plurality of rubber spring elements for mounting the mass body to the propeller shaft. Claim 18 further recites that at least one of the mass body and the propeller shaft at least partially form, in circumferentially opposite regions between the rubber spring elements, a plurality of stop elements for limiting a vibration travel of the mass body in at least the radial direction.

Michel appears to relate to an elastic support component. The Examiner contends that Michel shows in Figure 5 a vibration damper capable of being used for a tubular propeller shaft in the drive train of a motor vehicle. The Examiner further contends that vibration damper includes a propeller shaft 10 defining a radial and circumferential direction, a mass body 20 arranged concentrically in the propeller shaft and a plurality of spring elements 3 for mounting the mass body to the propeller shaft. It is the Examiner’s position that the folds 111 define a plurality of stop elements for limiting a vibration travel of the mass body in at least the radial direction. However, it is respectfully submitted that Michel does not disclose that the folds 111 satisfy the limitation of claim 18, which recites “at

least one of the mass body and the propeller shaft at least partially form, in circumferentially opposite regions between the rubber spring element, a plurality of stop elements for limiting a vibration travel of the mass body in at least the radial direction.”

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Additionally, to reject a claim under 35 U.S.C. § 102(b), the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claim, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claim, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claim must necessarily fail for the foregoing reasons.

VII. Rejection of Claims 9, 10 and 15 to 17 Under 35 U.S.C. § 103

Claims 9, 10 and 15 to 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,971,456 ("Hori"). It is respectfully submitted that Hori does not render obvious the present claims as amended herein for the following reasons.

Claim 9 relates to a vibration damper for a tubular propeller shaft in the drive train of a motor vehicle. Claim 9 recites that the vibration damper includes a sleeve defining a radial and circumferential direction, a mass body mounted concentrically in the sleeve, a plurality of rubber spring elements for mounting the mass body to the sleeve and a plurality of flexible stop elements. Claim 9 has been amended herein to recite that the flexible stop elements are disposed circumferentially between each adjacent pair of spring elements and disposed between the mass body and the sleeve for limiting a vibration travel of the mass body at least in the radial direction and that each stop element extends over a larger circumferential angle than the spring elements and occupy a large portion of a space between the mass body, the spring elements and the sleeve. The arrangement of the stop elements as recited in amended claim 9 is fully supported by the Specification and illustrated in the Figures.

Hori purports to relate to a fluid-filled elastic center bearing mount. Hori states that an elastic body includes a pair of integrally formed elastic protrusions 32, which protrude a suitable distance radially outwardly into respective third and fourth pockets 26, 27. Col. 5, lines 18 to 21. Hori further states that the elastic body 16 includes a pair of integrally formed elastic stops 34, which protrude a suitable distance into the respective first and second pockets 24, 25. Col. 5, lines 31 to 33. Hori states at col. 7, lines 48 to 51 that the elastic stops 34 serve to protect the elastic body 16 from an excessive amount of elastic deformation when the mount 10 receives vibrations of a considerably large magnitude. Hori does not, however, describe that the elastic protrusions 32 define such stops. Indeed, since the third and fourth pockets are stated to be filled with an incompressible fluid and since vibrations are stated to be applied in the load-receiving direction P, it is respectfully submitted that Hori specifically fails to teach that the protrusions 32 define flexible stop elements as recited in claim 9. As indicated above, claim 9 as amended herein recites that the flexible stop elements are disposed circumferentially

between each adjacent pair of spring elements. This recited arrangement of the flexible stop elements is neither taught nor suggested by Hori.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also suggest combining the elements in the manner contemplated by the claim. See, Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” See, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). It is respectfully submitted that, as discussed above, the reference relied on does not suggest in any way modifying, or combining, the reference so as to address the problems that are met by the presently claimed subject matter.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action’s generalized assertions that it would have been obvious to modify the reference relied upon do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added).

Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify a reference to provide the subject matter of the claims. Accordingly, the Office Action's assertions in this regard are irrelevant since the Office must provide proper evidence of a motivation for modifying a reference to provide the claimed subject matter.

Accordingly, there is no evidence whatsoever -- except subjective speculation -- that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 9. It is therefore respectfully submitted that claim 9 is allowable for these reasons.

As for claims 10, 15 and 16, which ultimately depend from claim 9, it is respectfully submitted that these dependent claims are allowable for at least the same reasons that claim 9 is allowable. In re Fine, *supra*.

Claim 17 relates to a vibration damper for a tubular propeller shaft in the drive train of a motor vehicle. Claim 17 recites that the vibration damper includes a propeller shaft defining a radial and a circumferential direction, a mass body arranged concentrically in the propeller shaft, a plurality of rubber spring elements for mounting the mass body to the propeller shaft and a plurality of stop elements, which include at least one of metal or rubber, for limiting a vibration travel of the mass body at least in the radial direction. Claim 17 has been amended herein to recite that the stop elements are disposed between the mass body and the

propeller shaft and circumferentially between each adjacent pair of rubber spring elements. As more fully set forth above with respect to claim 9, it is respectfully submitted that Hori does not teach or even suggest the arrangement of the stop elements as set forth in amended claim 17. It is therefore respectfully submitted that Hori does not render obvious amended claim 17.

VIII. Rejection of Claims 11 to 13 Under 35 U.S.C. § 103

Claims 11 to 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Michel in view of Hori. It is respectfully submitted that the combination of Michel and Hori does not render obvious the present claims for the following reasons.

Claim 11 relates to a vibration damper for a tubular propeller shaft in the drive train of a motor vehicle. Claim 11 recites that the vibration damper includes a sleeve defining a radial and circumferential direction, a mass body mounted concentrically in the sleeve and a plurality of rubber spring elements for mounting the mass body to the sleeve. Claim 11 further recites that at least one of the mass body and the sleeve at least partially form, in circumferentially opposite regions between the rubber spring elements, a plurality of stop elements for limiting a vibration travel of the mass body in at least the radial direction and that the stop elements extend over a larger circumferential angle than the spring elements. As more fully set forth above with respect to claim 18, the Examiner has failed to properly establish that the folds 111 shown in Figure 5 of Michel satisfy the limitation of "at least one of the mass body and the sleeve at least partially form, in circumferentially opposite regions between the rubber spring elements, a plurality of stop elements for limiting a vibration travel of the mass body in at least the radial direction" as recited in claim 11. Hori does not teach or even suggest at least this feature of claim 11. It is therefore respectfully submitted that the combination of Michel and Hori does not render obvious claim 11.

As for claims 12 and 13, which depend from claim 11, it is respectfully submitted that the combination of Michel and Hori does not render obvious these dependent claims for at least the same reasons given above in support of the patentability of claim 11. In re Fine, supra.

IX. **Rejection of Claim 14 Under 35 U.S.C. § 103**

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hori in view of U.S. Patent No. 4,988,071 ("Shimazaki et al."). It is respectfully submitted that the combination of Hori and Shimazaki et al. does not render obvious claim 14 for the following reasons.

Claim 14 depends from claim 9 and therefore includes all of the limitations of claim 9. Since claim 14 depends from independent claim 9, and since Shimazaki et al. simply does not cure the critical deficiencies of Hori, it is respectfully submitted that claim 14 is allowable for at least the same reasons that claim 9 is allowable.

X. **Conclusion**

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Dated: 8/10/01

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Version with Markings to Show Changes Made

IN THE SPECIFICATION:

The paragraph beginning on page 7, line 21 has been amended as follows:

Mass body 51 can also have the cross-sectional shape of a cup, so that it fits around carrier segment 23 of sleeve 21 (cf. cross-hatched widening of mass body 51). In addition, the mass body can have, for example, a cylindrical extension 59 at base 58 of the cup. [Said] The extension 59 would lie concentrically inside the external tubular segment 57 of mass body 51.

IN THE CLAIMS:

Claims 9, 14 and 17 have been amended as follows:

9. (Amended) A vibration damper for a tubular propeller shaft in the drive train of a motor vehicle, the vibration damper comprising:

a sleeve, the sleeve defining a radial and circumferential direction;

a mass body mounted concentrically in the sleeve;

a plurality of rubber spring elements for mounting the mass body to the sleeve; and

a plurality of flexible stop elements disposed circumferentially between [the] each adjacent pair of spring elements and disposed between the mass body and the sleeve for limiting a vibration travel of the mass body at least in the radial direction, wherein [the] each stop [elements extend] element extends over a larger circumferential angle than the spring elements and occupy a large portion of a space between the mass body, the spring elements and the sleeve.

14. (Amended) The vibration damper as recited in claim 9 further comprising a propeller shaft mounted concentrically with the sleeve and wherein the sleeve includes a first and a second tube segment joined together, the first tube segment having a greater outside diameter than an outside diameter of the second tube segment and corresponding approximately to an inside diameter of the propeller shaft, the second tube segment carrying [on an outer contour] the mass body on an

Version with Markings to Show Changes Made

outer contour, at least one of the plurality of spring elements connecting the second tube segment to the mass body, the mass body being annular at least in an area of connection with the second tube segment.

17. (Amended) A vibration damper for a tubular propeller shaft in the drive train of a motor vehicle, the vibration damper comprising:

a propeller shaft, the propeller shaft defining a radial and a circumferential direction;

a mass body arranged concentrically in the propeller shaft;

a plurality of rubber spring elements for mounting the mass body to the propeller shaft; and

a plurality of stop elements for limiting a vibration travel of the mass body at least in the radial direction, the stop elements being disposed between the mass body and the propeller shaft and circumferentially between [the] each adjacent pair of rubber spring elements, the stop elements including at least one of metal or rubber.

New claims 19 and 20 have been added.